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Richard A. Darrell

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. DARRELL

Appeal 2009-006757
Application 10/615,582
Technology Center 3600

Before: MURRIEL E. CRAWFORD, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-5, 7, 9, 11-15, 17, 18, 21, and 23. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to systems and methods for electronically displaying transaction receipt information to consumers or others (Spec., para. [0002]). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A method of presenting an image of a receipt to a consumer, comprising:
 - electronically capturing a receipt;
 - storing the receipt at a host computer system;
 - receiving a request at the host computer system from a computer of the consumer to display the image of the receipt;
 - transmitting an electronic file comprising the image of the receipt for display at the consumer computer, the electronic file further comprising programming that causes at least one purchase item included on the receipt to appear as a selectable link to obtain more detailed information about the item;
 - receiving from the consumer computer information that defines at least one user-defined category based on product information;
 - receiving a request at the host computer from the consumer computer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts;
 - for each of the plurality of receipts, consulting a database for product information relating to each item of the receipt;
 - using the product information to sort the items into categories comprising the at least one user-defined category;
 - and

transmitting a second electronic file from the host computer system to the consumer computer, wherein the file comprises a listing of the items sorted into categories comprising the at least one user-defined category based on product information for display at the consumer computer.

The references of record relied upon by the Examiner as evidence of obviousness are:

Thompson	US 6,282,552 B1	Aug. 28, 2001
Schultz	US 2001/0029470 A1	Oct. 11, 2001
Houvener	US 6,397,194 B1	May 28, 2002

Claim 18 stands rejected under 35 U.S.C. § 101 for failing to recite patentable subject matter; claims 1-5, 7, 9, 11-15, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Houvener in view of Schultz; and claims 21 and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Schultz.

We REVERSE.

ISSUES

Did the Examiner err in asserting that independent claim 18 recites patentable subject matter under 35 U.S.C. § 101?

Did the Examiner err in asserting that a combination of Houvener and Schultz render obvious the subject matter of claims 1-5, 7, 9, 11-15, 17, 18, 21, and 23?

ANALYSIS

101 Rejection

We are persuaded the Examiner erred in asserting that independent

claim 18 recites patentable subject matter under 35 U.S.C. § 101 (App. Br. 5; Reply Br. 1). Page 4 of the Appeal Brief lists an image capture device, host computer system 102, database 106, and financial statement processing computer 110 as corresponding to the various “means” set forth in independent claim 18. These devices denote sufficient structure to meet the machine prong of the machine-or-transformation test. *See Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010) (the machine-or-transformation test may be a useful and important clue or investigative tool for deciding whether an invention is a patent-eligible “process” under §101).

Obviousness Rejection

We are persuaded the Examiner erred in asserting that a combination of Houvener and Schultz renders obvious the subject matter of claims 1-5, 7, 9, 11-15, 17, 18, 21, and 23 (App. Br. 5-9; Reply Br. 1-3). Appellant asserts that the Examiner has improperly failed to give patentable weight to “receiving from the consumer computer information that defines at least one user-defined category based on product information,” as recited in independent claim 1 (App. Br. 7). We agree because the Examiner has failed to show how either Houvener or Schultz “defines at least one user-defined category.” The Examiner is generally correct that a printed matter rejection is appropriate where the general function is described and all that differs between the references and the claimed invention is the information contained within. *See In re Gulack*, 703 F.2d 1381, 1385-86 (Fed. Cir. 1983) (“[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability”). Accordingly, because Houvener and Schultz

disclose computers exchanging information, it is tempting to assert that the content of the information is irrelevant, and thus ripe for a printed matter rejection. However, independent claim 1 also recites “using the product information to sort the items into categories comprising the at least one user-defined category.” Thus, the “user-defined category” is no longer printed matter because the content of the information received from the consumer computer affects the underlying operation of the claimed invention; if no user-defined categories are received at the host computer, no sorting can be performed. And contrary to the Examiner’s assertion on page 13 of the Examiner’s Answer, the sorting is not merely an intended use, as the sorting step is positively recited within the step of “using the product information.”

DECISION

The Examiner’s decision is REVERSED.

REVERSED

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